

AMENDMENT
Serial No. 09/557,119

YOR9-2000-0023-US1

REMARKS

Claims 1 – 40 remain in the application and stand rejected. Claims 1, 6 – 8 and 26 are amended herein. No new matter has been added.

Claims 1, 6, 8 and 26 are objected to for containing informalities. Claim 7 is rejected under 35 U.S.C. §112 as being indefinite. Claims 1, 6, 7 and 26 are amended substantially as suggested by the Examiner. Claim 7 is amended herein to remove the alleged indefiniteness. Accordingly, reconsideration and withdrawal of the objection to Claims 1, 6, 8 and 26 and the rejection of claim 7 is respectfully solicited.

Claims 15 – 19 and 32 are rejected under 35 U.S.C. §102(b) over U.S. Patent No. 4,836,219 to Hobson et al. The Applicants note that claim 15 depends from claim 6, which depends from claim 1. Claim 1 is not rejected over Hobson et al., either alone or in combination with any other reference of record. Therefore, because claim 1 is not unpatentable over Hobson et al., claims 15 – 19, which depend from claim 1 are not unpatentable under 35 U.S.C. §102(b) over Hobson et al. Independent claim 32 is directed to, a program product for operating a programmable alarm clock, which is quite different than anything described in the electronic reporting device description of Hobson et al. Accordingly, Hobson et al. does not make claim 32 unpatentable under 35 U.S.C. §102(b). Reconsideration and withdrawal of the rejection of claims 15 – 19 and 32 under 35 U.S.C. §102(b) over Hobson et al. is respectfully solicited.

Claims 1, 4, 8 – 13, 21 – 24 and 32 – 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,928,133 to Halyak. Claims 2, 3, 5 – 7 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Halyak in view of U.S. Patent No. 5,902,250 to Verrier et al. Claims 25 – 28, 30 and 35 – 40 are rejected under

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35 U.S.C. §103(a) as being unpatentable over the combination Halyak and Verrier et al. and further in view of Hobson et al.

In responding to the previously filed Request for Reconsideration, the examiner asserts that, although the prior art of record may not include certain features of Applicant's invention, those features "(i.e., the sleep analyzing server analyzes the signal and *provides the analysis back* to the local computer which determines the best time to wake the sleeper) are not stated in the claims." (Emphasis the Examiner's.) Claim 8 clearly recites "wherein said local computer is further provided with a selected sleep activity, the sleep analyzing server sending information about identified periods of said selected sleep activity to said local computer and said local computer determines from received said information when to trigger said wake up alarm relative to said wake up time." Lines 1 – 5. Further, claim 15, which is rejected over the electronic reporting device of Hobson et al., recites that the server receives sleep activity, charts and analyzes sleep data for sleep activity periods, and sends labeled charts to the local computer. Lines 2 – 8. *See also*, claims 24 – 28 and 34 – 36.

Regarding the rejection of claims 1, 4, 8 – 13, 21 – 24 and 32 – 34, although not finding the invention as claimed in Halyak, the Examiner asserts that Halyak essentially discloses the invention. Halyak et al. teaches an "apparatus 10 (that) consists,... of a control housing 14, a sensor 12, and a communicating cable 16. In this embodiment, sensor 12 comprises a pair of electrodes, which measure the electrical resistance of the user 2." *See*, col. 3, lines 59 – 63. Figure 2 shows the control unit 14 with a connected sensor 12 and nothing else. *See, e.g.*, col. 4, lines 11 – 24. The control unit 14 includes a clock 18, microprocessor 20, buzzer 22 and display 27. *Id.* Figure 4 shows control unit 14 operation as described at col. 5, lines 16 – 35.

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Regarding the rejection of claims 1, 4, 8 – 13, 21 – 24 and 32 – 34, although not finding the invention as claimed in Halyak, the Examiner asserts that Halyak essentially discloses the invention. Halyak et al. teaches an "apparatus 10 (that) consists,... of a control housing 14, a sensor 12, and a communicating cable 16. In this embodiment, sensor 12 comprises a pair of electrodes, which measure the electrical resistance of the user 2." *See*, col. 3, lines 59 – 63. Figure 2 shows the control unit 14 with a connected sensor 12 and nothing else. *See, e.g.*, col. 4, lines 11 – 24. The control unit 14 includes a clock 18, microprocessor 20, buzzer 22 and display 27. *Id.* Figure 4 shows control unit 14 operation as described at col. 5, lines 16 – 35.

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The Examiner asserts that Halyak's "microprocessor (20) stores and compares the data and the control unit (14) allows the user to pick a time interval in which to awakened or to choose a time after which they wish to awakened, the device will then wait until one of these optimal wake up points is reached and then activate an alarm (22), a clock (18) having a timer chip a display (27),..." As pointed out above, all of this describes control unit 14 operation and is contained in the control unit 14. The Examiner makes note of "an optional central processor/network computer (that) may be used by a supervisor of a group to wake the next individual who experiences an optimal wake-up point (see column 5, lines 39-44). In this sense the central processor could act as a sleep analyzer."

Though it is possible that the sleep analyzing server of the present invention could function as the optional central microprocessor of Halyak, there is nothing in Halyak, nor in any other reference of record to suggest that the converse is true (i.e., the optional central microprocessor functioning as a sleep analyzing server) as suggested by the Examiner. Neither does the Examiner provide any basis for a suggestion to adapt the optional central microprocessor, which is disclosed as being programmed to wake an individual, to act as a sleep analyzing server as described in the application (e.g., Figure 1, element 112 and page 6, lines 13 - 21) or as claimed. That it could be done does not make it so. Accordingly, it is apparent that the Examiner is using the invention for the suggestion to adapt the optional central microprocessor to result in the sleep analyzing server of the claimed invention. Such a use of the application, in hindsight is improper.

In spite of this, the Examiner concludes that "Halyak discloses all the subject matter claimed by applicant with the exception of the limitations stated in claim 1, i.e., the alarm device being remote." For a teaching and suggestion of making the alarm device remote, the Examiner asserts that it "would have been obvious to one having

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ordinary skill in the art at the time the invention was made to separate the alarm from the control unit, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. See *Nerwin v. Erlichman*, 168 USPQ 177, 179." Given the present trend in the related arts to miniaturize and integrate, the applicants contend that the opposite would have been obvious, i.e., to shrink and combine the elements of Halyak into a single miniature unit, perhaps the size of a watch that could be worn on the arm in place of Halyak's sensor 12. Again the Examiner must be using the application in improper hindsight.

The Examiner concludes that "claims 21-24: the method steps will be met during the normal assembly of the apparatus stated above." The applicants could not find and the Examiner has not identified anywhere that any of claims 21 - 24 are taught, disclosed or suggested in any reference of record. As far as the applicants are aware, an assertion that combining references to result in claim A will result in claim B is not sufficient to reject claim B. Without practicing claim A, one never gets to claim B. The rejection of a claim must stand on its own and there is no basis in 35 U.S. C. §103(a) for a rejecting one claim because it inherently occurs when practicing another. As 35 U.S. C. §103(a) directs, "the subject matter as a whole" must be examined for each claim, including claims 21 - 24, each on its own merit. Nowhere does Halyak or any reference of record teach or suggest the invention as recited in claims 21 - 24. Neither does the Examiner assert the presence of any such teaching or suggestion. Again it is apparent that for this rejection of claims 21 - 24, the Examiner is using the application in improper hindsight. Accordingly, the Examiner has not put forth a *prima facie* case for finding claims 21 - 24 obvious.

Accordingly, because Halyak does not teach or suggest a sleep analyzing server analyzing sleep signals as described or claimed; because there is no suggestion anywhere that the Examiner has provided to separate "a formerly integral structure

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in(to) various elements" as the Examiner alleges; because the method recited in claims 21 - 24 is not taught or suggest in any reference of record; and, because the Examiner is clearly using the application in improper hindsight to teach the invention, the present invention as claimed in claims 1, 4, 8 - 13, 21 - 24 and 32 - 34, is patentable over Halyak under 35 U.S.C. §103(a). Reconsideration and withdrawal of the rejection of claims 1, 4, 8 - 13, 21 - 24 and 32 - 34 under 35 U.S.C. §103(a) over Halyak is respectfully solicited.

Regarding the rejection of claims 2, 3, 5 - 7, 14, 25 - 28, 30 and 35 - 40 over Halyak in combination with Verrier et al. alone or in view of Hobson et al. Neither does either of Verrier et al. or Hobson et al. teach or suggest a sleep analyzing server analyzing sleep signals as described or claimed in claims 1, 24 and 34 from which claims 2, 3, 5 - 7, 14, 25 - 28, 30 and 35 - 40 depend. Therefore, the combination of Halyak with each or both of Verrier et al. or Hobson et al. does not result in the present invention as recited in any of claims 2, 3, 5 - 7, 14, 25 - 28, 30 and 35 - 40 or of claims 15 - 19 or 32. Reconsideration and withdrawal of the rejection of claims 2, 3, 5 - 7, 14, 25 - 28, 30 and 35 - 40 under 35 U.S.C. §103(a) is respectfully solicited.

The applicants have considered the other references cited but not relied upon in the rejection and find them to be no more relevant than the references upon which this rejection is based.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request that the Examiner reconsider and withdraw the objection to the claims and the rejection of claims 1 - 40 under 35 U.S.C. §§ 103(a) and 112 and allow the application to issue.

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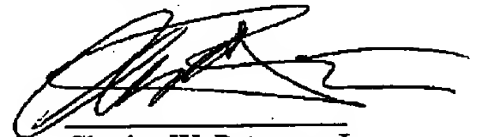
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Should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 50-0510 and advise us accordingly.

Respectfully Submitted,



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May 8, 2003

(Date)

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